

**REMARKS**

**I. Claim Objections**

The Examiner objected to claims 2 and 4-12 because of the following informalities:

The Examiner stated that claims 2, 6, 7, 10 and 11 depend from claim 1 which provides "a catalogue". The Examiner stated that the dependent claims refer to a "catalog".

The Applicant notes that claim 1 has been amended to refer to a "catalog" in response to this objection.

The Examiner stated that claims 4, 8 and 12 claim "an electronic interfaces" and assumed this is a misspelling of "interface".

The Applicant notes that claims 4, 8 and 12 have been amended to "interface" in response to this objection.

The Examiner stated that claim 5 contains the phrase "where at the selection is produced ..." and assumed that the inclusion of the word "at" is in error.

The Applicant notes that claim 5 has been amended to replace "where at" with "wherein" in response to this objection.

The Examiner stated that claim 9 contains the phrase "distribution facilities authentication..." and assumed that the possessive form was intended, such as "distribution facilities' authentication...".

The Applicant notes that claim 9 has been amended to "on-site authentication" and to replace the plural "facilities" to the singular "facility" in response to this objection.

Based on the foregoing, the Applicant respectfully requests that the Examiner's objections to claims 2 and 4-12 be withdrawn.

**II. Claim Rejections - 35 USC §112**

The Examiner rejected claims 1-20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the Examiner argued that the claim recites the limitation "the customer" in line 10. The Examiner argued that there is insufficient antecedent basis for this limitation in the claim.

The Applicant notes that claim 1 has been amended to replace "customer" with "traveler" in response to this rejection.

Regarding claim 9, the Examiner argued it is unclear as to what is being scheduled, distribution of the selection or distribution of the facilities. The Examiner stated that if the latter, it is unclear how one automatically schedules distribution of facilities. The Examiner stated that it is further unclear how a traveler's identity is authenticated as a result of scheduling distribution. The Examiner stated that it is also unclear how the selection is made available to the traveler after the traveler's identity is authenticated by distribution "facilities". The Examiner argued that in other words, the claim appears to require some type of identification verification, but the language points to a single traveler's identity being authenticated by a plurality of facilities. The Examiner argued that the claim is sufficiently unclear as to afford a reasonable understanding of the metes and bounds of the claim.

The Applicant notes that claim 9 has been amended to refer to a "pick-up facility" with on-site authentication of the traveler's identity at the pick-up facility in response to this rejection.

Regarding claim 13, the Examiner argued that the claim recites the limitations "the publications: in line 2; "traveling customers" and "the customer's" in line 3. The Examiner argued that there is insufficient antecedent basis for these limitations in the claim. The Examiner argued that the claim language alternatively refers to a singular traveler/customer and a plurality of traveling customers. The

**Patent Application Serial No. 10/694,138**

Examiner argued that this renders the claim indefinite by stating "a publication" is ordered "by a traveler" and having "the publications" ready for "customers after the customer's arrival".

The Applicant notes that claim 13 has been amended for the sake of clarity, wherein the entire clause referred to by the Examiner has been removed in response to this rejection.

Regarding claim 15, the Examiner argued that the claim recites the limitation "the electronic interface" in line 2. The Examiner argued that there is insufficient antecedent basis of this limitation in the claim. The Examiner argued that the claims from which claim 15 depends recite the use of a *remote* electronic interface.

The Applicant notes that claim 15 has been amended to add the term "remote" in response to this rejection.

Regarding claim 18, the Examiner argued that the claim recites the limitations "the publications" in line 2; "traveling customers" and "the customer's" in line 3. The Examiner argued that there is insufficient antecedent basis for these limitations in the claim. The Examiner argued that the claim language alternatively refers to a singular traveler/customer and a plurality of traveling customers. The Examiner argued that this renders the claim indefinite by stating "a publication" is ordered "by a traveler" and having "the publications" ready for "customers after the customer's arrival".

The Applicant notes that claim 18 has been amended for the sake of clarity, wherein the entire clause referred to by the Examiner has been removed in response to this rejection.

Regarding claim 20, the Examiner argued that the claim recites the limitation "electronic interfaces" in line 2. The Examiner argued that there is insufficient antecedent basis for this limitation in the claim. The Examiner argued that claim 18 (from which claim 20 depends) recites the use of an electronic interface (singular).

The Applicant notes that claim 20 has been amended to refer to the singular "interface" in response to this rejection.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §112, second paragraph, rejections of claim 1-20 be withdrawn.

### **III. Claim Rejections - 35 USC § 103**

#### ***Requirements for Prima Facie Obviousness***

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

***Lundgren***

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Lundgren (U.S. Patent Publication No. 2003/0048471).

The Examiner argued that Lundgren discloses providing aircraft passengers (i.e., en-route customer) with internet access (citing Lundgren paragraph [0003]) whereby a "laptop computer or handheld computer" is connected "to an Internet web site for accessing a printing management application: where printing is performed "at a designated airport or at other locations designated by the user", (citing Lundgren paragraph [0007]). The Examiner argued that when selecting the printing and delivery options, including printing to printers at airports, the traveler is able to electronically select production facilities near the traveler's destination (citing Lundgren paragraph [0018]).

The Examiner argued that the document is printed at the location specified by the traveler and is picked up "at the airport after the aircraft has landed" (citing Lundgren paragraph [0020]), thus the document is distributed to a pick-up facility as chosen by the traveler. The Examiner argued that Lundgren discloses that documents can be reviewed from the Internet (citing Lundgren paragraph [0004]). The Examiner argued that in this regard, it is obvious that documents that are reviewed from the internet include previously published works, i.e., *publications*. The Examiner argued that therefore, publications are ordered from the Internet when the traveler provides user ID and billing information to the printing services application (citing Lundgren paragraph [0018]).

The Applicant respectfully disagrees with this assessment and notes that claim 13 has been amended to the following:

A method for automatically producing a publication, comprising:  
receiving an electronic order for a publication over an electronic network from a traveler using a remote electronic interface;  
producing the publication using a print on demand system located near a destination selected by the traveler for pick-up of the publication wherein the printing of the publication and publication cover and the binding of the publication block is performed by the print on demand system ; and  
distributing the publication to a pick-up facility located at the destination selected by the traveler for pick-up of the publication.

The Applicant notes that claim 13 has been amended to standardize the terminology, utilizing the term "print on demand" instead of "publish on demand". This is the term utilized in the Applicant's FIG. 4. Additionally, claim 13 has been amended to clarify the term "print on demand" with the definition from the Applicant's paragraph [0023]; i.e. wherein the printing of the publication and publication cover and the binding of the publication block is performed by the print on demand system.

"Print on demand" is the commonly utilized term in the art to describe a printing technology wherein new copies of books or other publications offered for sale are printed only *after* an order for the book has been received. This technology reduces the cost of publishing by reducing the necessity of large inventories of the book and little or no waste in the printing process as only purchased books are actually printed. A print on demand system includes the printing of the publication, the printing of the cover and the *binding* of the book block. The Applicant's invention utilizes this technology with the additional innovation of in-route ordering, print on demand at a facility and pick-up at the traveler's destination.

Lundgren does not disclose a print on demand system. Lundgren paragraph [0007] discloses a document is printed on a printer. A printer is not a print on demand system, as the terms are utilized in the art. As noted above, a print on demand system includes not only printing of the publication and cover but also the

binding of the book block. Lundgren simply does not disclose a print on demand system where the printing of the publication and publication cover and the binding of the book block are performed.

Lundgren also does not disclose an *electronic order* for a *publication*. The term "electronic order" as utilized in the Applicant's specification is a purchase of a publication through the network, as disclosed in the Applicant's paragraph [0020]. Lundgren does not disclose that a purchase is made of a publication, only that the customer pays for the *printing* of documents. Lundgren paragraph [0018] discloses that "Billing information is requested in order to charge the user for the services requested." In other words, the system of Lundgren does not offer the document being printed for sale as any documents printed are located on the customer's computer itself. Lundgren is a system and method of printing computer documents, not a method and system of *ordering* books and publications.

Therefore, Lundgren does not disclose: 1) receiving an electronic order, 2) producing the publication using a print on demand system, or 3) wherein the printing of the publication and publication cover and the binding of the publication block is performed by the print on demand system.

Lundgren therefore fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 13 based on the Lundgren reference be withdrawn.

### ***Lundgren in view of Marsh***

The Examiner rejected claims 1-12 and 14-20 under 35 USC§103(a) as being unpatentable over Lundgren (U.S. Patent Publication No. 2003/0048471) in view of Marsh (U.S. Patent Publication No. 2002/0061238).

Regarding claims 1-12 and 14-20, the Examiner argued that Lundgren discloses providing aircraft passengers (i.e., en-route customer) with Internet access (citing paragraph [0003]) whereby a "laptop computer or handheld

computer" is connected "to an Internet web site for accessing a printing management application" where printing is performed "at a designated airport or at other locations designated by the user" (citing paragraph [0007]). The Examiner argued that when selecting the printing and delivery options, including printing to printers at airports, the traveler is able to electronically select production facilities near the traveler's destination (citing paragraph [0018]). The Examiner argued that Lundgren further discloses requiring "user identification (ID) and account information, including billing information such as credit card number" be provided to the printing services application. The Examiner argued that this information is used to "track any print job initiated through the printing services application" (citing paragraph [0018]). The Examiner argued that it is obvious that upon pick-up of the selection, the traveler's identity would be authenticated in that the print order would be matched against the user ID and the billing information provided by the traveler when the selection was ordered. The Examiner argued that a remote pick-up location would be motivated to verify customer IDs and account information to ensure that print orders are released to the customer who ordered it.

The Examiner admitted that Lundgren does not disclose a catalogue from which publications can be selected.

The Examiner argued that Marsh, however, discloses an online system for ordering and printing books on demand in which customers' access via the Internet to view the books in the digital library (i.e., preview the books in a catalogue or database), select and order the book and command the book to be printed.

The Examiner argued that therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included selecting and previewing publications to be printed from an online catalogue, as disclosed by Marsh in the system disclosed by Lundgren, for the motivation of fulfilling book orders without the need to stock the inventory (citing Marsh; paragraph [0052]). The Examiner argued that furthermore, books that are no longer in print would be able to be ordered. The Examiner stated that therefore,



ordering anything from the Internet, including books to be printed on demand, is an obvious expansion of Lundgren system.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of claim 13 over Lundgren applies equally against the rejections over Lundgren in view of Marsh. As submitted above, Lundgren does not disclose: 1) receiving an electronic order/selection, 2) producing the publication using a print on demand system, or 3) wherein the printing of the publication and publication cover and the binding of the publication block is performed by the print on demand system.

The Applicant notes that claim 1 has been amended to include the limitation "wherein the printing of the publication and publication cover and the binding of the publication block is performed by the print on demand system" as argued above.

The Examiner has cited Marsh for the disclosure of the catalog and the print on demand system; however the Applicant submits that it would not be obvious to combine the Lundgren and Marsh references. As submitted above, the system of Lundgren prints a document from the traveler's computer. The system of Lundgren is not a print on demand system and is not capable of being utilized in a print on demand system.

The MPEP requires a reasonable expectation of success of the combination of references; however, there would not be an expectation of success of Lundgren in view of Marsh as ordered books could not be printed on the system of Lundgren. As the system of Lundgren is unable to print books (i.e., printed publications including a cover and binding), there would be no motivation to combine the references.

Additionally, the Examiner has cited Marsh for disclosing a catalog; however, Marsh discloses accessing the book server through the internet only without disclosing a printed catalog. The Applicant notes that claim 2 has been amended to refer to the catalog in printed form which is not disclosed by Marsh. As the Examiner has admitted that Lundgren does not disclose a catalog, the combination Lundgren in view of Marsh does not disclose a *printed* catalog.

The Applicant therefore submits that Lundgren in view of Marsh fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims are not disclosed. Additionally, there would not be a reasonable expectation of success of the combination of the Lundgren and Marsh references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 1-12 and 14-20 based on the Lundgren and Marsh references be withdrawn.

#### **V. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §112 and 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



Dated: March 6, 2008

---

Kermit Lopez  
Attorney for Applicants  
Registration No. 41,953  
ORTIZ & LOPEZ, PLLC  
P.O. Box 4484  
Albuquerque, NM 87196-4484  
Tel. 505-314-1312